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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/236,933	05/02/1994	DONALD R. HUFFMAN	7913ZAZY	4115

7590 12/20/2001

LEOPOLD PRESSER
SCULLY, SCOTT, MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER
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ART UNIT	PAPER NUMBER
1754	48

DATE MAILED: 12/20/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

Paper No. 48

Application Number: 08/236,933
Filing Date: 5/2/94
Appellant(s): Donald R. Huffman et al.

Mark Cohen
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 5/7/01, noting the communications filed subsequently thereto.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief, and contains a minor error. '508,246' should be - 580,246 -.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct, however the recitation of the history is incomplete as it does not indicate when claims 232-248 were added.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct, except in so far as it makes arguments which are traversed below.

(6) Issues

Appellant's statement of issues is correct; it is noted that some of the rejections under '112 second paragraph are withdrawn.

(7) Grouping of Claims

All claims do not stand or fall together. Claims 45-49, 51-82, 96, 203 and 232 stand or fall together- brief pg. 15 bottom.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

There is no prior art of record relied upon in the rejection of claims under appeal.

(10) New Prior Art

No new prior art has been applied in this examiner's answer.

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 45*-49, 51-84, 96, 181 and 203-248 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection, and explanations appertaining thereto, is the same as in paper 40, incorporated herein by reference, except as corrected to include claim 45. Also, the rejections of 'solid' and 'discernible' are withdrawn.

* In paper 36- remailed without modification as paper 40- the rejected claims are listed as '46-49, ...'. The rejection recites a defect in claim 45. On Brief pgs. 13 and 16, appellant indicates that claim 45 was taken to be rejected ('Do the claims on appeal...' and '... viz., Claims 45-49 ...'). Therefore, the rejection of claim 45 herein is deemed to be correction of an obvious error, and not a new ground of rejection.

Claims 45-49, 51-82, 96, 203 and 232 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection, and explanations appertaining thereto, is the same as in paper 40, incorporated herein by reference.

Claims 45-49, 51-82, 96, 203 and 232 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the preparation of a two-micron thick C60 coating, does not reasonably provide enablement for all macroscopic amounts of C60. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

This rejection, and explanations appertaining thereto, is the same as in paper 40, incorporated herein by reference.

(12) New Ground of Rejection

This examiner's answer does not contain any new ground of rejection.

(13) Response to argument

Concerning the '112 second paragraph rejection, the term 'solid' is not being rejected in isolation. Rather, it goes hand in hand with the rejection of the terms 'discernible' and 'macroscopic'. In view of the arguments and the specification, the rejection of 'solid' as used in the claims is withdrawn. Also rejected as indefinite is how much material yields a colored solution. It is noted that objective criteria, such as transmission at a certain wavelength, is not used to define this term. Moreover, the perception of color lies, literally, in the eye of the beholder. Suffice it to say that it is well known that there are those individuals with impaired color perception, from common red/green 'color blindness' to the rare few who lack the cones necessary. Also, the intensity of the color necessary for it to be 'colored' is unclear (assuming for the sake of argument that 'colored' is clear). It is submitted that 'whether an organic solvent becomes colored' is therefore *not* an 'objective test' (Brief pg. 20). If the sample is not pure, then it can be the contaminants that cause the color (assuming for the sake of argument that 'colored' is clear). Note that the claims (claim 84 for example) recite the C60 being 'capable' of making the color, which adds yet another layer of confusion as to what exactly is required in the claim- whether a color is required and what steps could be performed to cause

the C60 to make the solution colorless to colored (assuming for the sake of argument that 'colored' is clear). The rejection of 'discernible' is withdrawn.

Concerning the rejection of 'macroscopic', the arguments by the Board of Appeals in pages 30-36 of paper 88 of interference 103,281 (involving 07/580246) is incorporated herein by reference. The term 'macroscopic' includes amounts not contemplated in the specification. Put another way, just because the specification has amounts which are macroscopic does not mean that the whole meaning of the term is supported. To use an analogy, the discussion of 'carbon' in the specification does not provide support for the formation of diamonds. The argument on pg. 24 of the Brief that macroscopic and discernible are defacto synonyms is logically flawed; C60 was first 'discerned' in space dust even though it was not physically observed nor recovered. Thus, the arguments are not persuasive. In converse, the 'macroscopic' amounts of C60 here on earth escaped discernment (detection) for a long time. The unidentified Kroto Declaration- presumably filed 6/21/95- was discussed in paper 8/7/96 in paper 8. It has been considered. So has the unidentified Kroto Declaration. The objection to the lack of witnesses skilled in the art deposed by the PTO can be dismissed simply by noting that the PTO does not depose outside witnesses during the prosecution of a patent application. On pg. 29 of the Brief, appellants mischaracterize the holding of the Board of Appeals on the issue of 'macroscopic', and thus their comments are not persuasive.

Concerning the enablement issue, the above arguments apply, and are incorporated herein. Example 1 is not of sufficient detail as to provide guidance on obtaining any desired macroscopic amount (presuming arguendo that this is clear) of C60, since (for example) the effect on increasing pressure due to the presence of more C60 is not reported. Moreover, the

development of the field since the earliest filing date of the present subject matter, and the lessons learned by the Declarants, should be remembered. It is asserted that at the time of filing, the specification was not sufficiently enabling for the scope of what is claimed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

S. Hendrickson
11/15/01

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